

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the Amendment filed on April 11, 2008 and the following comments.

In the April 11, 2008 Amendment, claim 1 was amended to be directed a flame-retardant pressure-sensitive adhesive comprising

- (a) at least one acrylate adhesive component,
- (b) a flame retardant component consisting of ammonium polyphosphate, and
- (c) at least one tackifying resin component,

wherein said flame retardant component is the sole flame retardant component in the pressure-sensitive adhesive.

Since this Response is being filed along with the RCE, no showing under 37 CFR § 1.116(b) is believed to be required.

In the April 21, 2008 Advisory Action, the Examiner indicates that the claim amendments as set forth in the April 11, 2008 Amendment overcome the prior art of record, since art applied against the present claims require synergistic mixture of ammonium polyphosphate with another nitrogen containing compound.

The Examiner alleges having difficulty locating explicit support for the proposed amendment. The Examiner also alleges that Applicants only mention in their specification ammonium phosphate, however there is no statement that indicates that

addition of other flame retardants is excluded. Applicants respectfully disagree with these allegations.

Applicants submit that the amendment to claim 1 to exclude other flame retardant components except the ammonium polyphosphate flame retardant component does not introduce new matter. Applicants concede that claim 1 does not appear *ipsis verbis* in the specification as originally filed. Nevertheless, new matter has not been introduced because Applicants point out that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added word is a word that is used in the application as filed, but whether the concept embodied by the added word is present in the original specification as filed. See, e.g., *In re Anderson*, 176 USPQ 331, 336 (CCPA 1973). A function of the written description requirement is to ascertain whether as of the filing date, a person skilled in the art would understand that the Applicants had possession of the invention as it is now claimed- that is, an adhesive having an ammonium polyphosphate flame retardant component as the sole flame retardant component in the adhesive. There are a number of specific embodiments in the specification and the examples, such as Examples 1-3, each of which shows flame-retardant pressure-sensitive adhesives as presently claimed with a sole flame retardant component consisting of ammonium polyphosphate. Therefore, a person skilled in the art would understand that as of the filing date of the present application, Applicants did, in fact, have possession of the embodiments as presently claimed, i.e. a flame-retardant pressure-sensitive adhesive having a sole ammonium polyphosphate flame retardant component as evidenced by the examples. In view of *In re Anderson*, it does not

introduce new matter to amend the claims to recite the ammonium polyphosphate flame retardant component is the sole flame retardant component, since that concept is conveyed by the present examples wherein the flame-retardant pressure-sensitive adhesive is formed without any other flame retardant components except the ammonium polyphosphate flame retardant component. Consequently, the present claims do not introduce new matter.

Negative limitations are sometimes objectionable. However, there is nothing inherently ambiguous or uncertain about negative limitations, so long as the boundaries of the patent protection sought are set forth definitely and the negative limitation has a basis in the original specification as filed. See MPEP §2173.05(j). The negative limitation introduced here has a basis in the original specification, as discussed above.

The case *Ex parte Grasselli* is sometimes cited to support a position that an amendment to introduce a new matter limitation is presumptively improper. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983). However, it is interesting to note that *Ex parte Grasselli* in turn relies on *In re Anderson* which is discussed herein above. Again, *In re Anderson* stands for the proposition that a lack of express support is not determinative, but rather the question is whether the concept embodied by the added word is present in the original specification. In *Ex parte Grasselli* there was no support in the original specification for concept embodied by the added negative limitation, and therefore relying on *In re Anderson*, the negative limitations did in fact introduce new matter. In the present case, however, as the Applicants have explained above, the

concept embodied by the added negative limitation is supported by the original specification as filed as evidenced by the examples which include ammonium polyphosphate as the sole flame retardant component. Therefore, unlike the situation in *Ex parte Grasselli*, there is support for the concept embodied by the added negative limitation and therefore, relying on *In re Anderson*, the negative limitation addition should be allowed.

In view of the April 11, 2008 Amendment and the above remarks it is believed that claims 1-32 are now in condition for allowance. Reconsideration of the claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,  
NORRIS, McLAUGHLIN & MARCUS, P.A.

By /Brian C. Anscomb/  
Brian C. Anscomb  
Reg. No. 48,641

BCA/hs  
875 Third Avenue- 18<sup>th</sup> Floor  
New York, New York 10022  
(212) 808-0700